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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,085	07/15/2003	Minoru Kawahara	450100-04652	7420

7590 07/22/2008  
FROMMER LAWRENCE & HAUG LLP  
745 FIFTH AVENUE  
NEW YORK, NY 10151

EXAMINER
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LONG, ANDREA NATAE

ART UNIT	PAPER NUMBER
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2176

MAIL DATE	DELIVERY MODE
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07/22/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/620,085	<b>Applicant(s)</b> KAWAHARA ET AL.	
	<b>Examiner</b> Andrea N. Long	<b>Art Unit</b> 2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2008 and 28 April 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/28/2008 and 04/28/2008 has been entered.

### **Applicant's Response**

In Applicant's Responses dated 03/28/2008 and 04/28/2008, Applicant amended Claims 1, 6, and 7, and argued against all objections and rejections previously set forth in the Office Action dated 01/28/2008.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 3-5 and 7 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 is considered software per se. Computer programs may be explicitly claimed as, for example, a series of code or instructions for performing functions or may be implicitly claimed as, for example, a system, a module or an apparatus. Where there is no evidence in the

specification that a means which may be interpreted as software, hardware or combinations thereof necessarily includes hardware, it will be interpreted in its broadest reasonable sense as a software means, which is the case here.

Thus a claim to functional descriptive material, including computer programs, per se, is not patent eligible subject matter. Claims 3-5 are rejected as inheriting the deficiencies of claim 1.

Claim 7 is not limited to tangible embodiments. In view of Applicant's disclosure, specification page 53, line 20, to page 54, line 24, the medium is not limited to tangible embodiments, instead being defined as including both tangible embodiments (e.g., CD-ROMS, DVD) and intangible embodiments (e.g., transmission media). As such, the claim is not limited to statutory subject matter and is therefore non-statutory.

To overcome this type of 101 rejection the claim need to be amended to include only the physical computer media and not a transmission media or other intangible or non-functional media.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1 and 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lang (US Patent 5164839) hereinafter “Lang”, in view of Lindsey et al (US Patent 6226296 B1), hereinafter “Lindsey” in further view of Jouenne et al (US Patent 6286085 B1), hereinafter “Jouenne”.**

*For the convenience of the Applicant, the Examiner has pointed out particular references contained in the prior art(s) of record in the body of this action. Although the specified citations are representations of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. The Applicant should consider the entire reference(s) as applicable as to the limitations of the claims.*

**As to independent claims 1, 6, and 7,** Lang discloses *a data processing apparatus, method and a program for causing a computer to execute a data processing method for processing audio visual data made up of video or audio data* (column 3 lines 40-50 → Lang teaches an audio/video device for manipulating data)

*said data processing comprising:*

*receiving means for receiving an edit procedure data including edit command specifying how to edit said audio visual data* (column 6 line 53 through column 7 line 5 → Lang teaches a user interface controlled by a user to edit the data);

*analyzing means for analyzing edit procedure data and recognizing the edit command in the edit procedure data (column 6 lines 63-68 → Lang teaches a user viewing and examining frames of the audio video data for editing);*

*editing means for editing said audio visual data in accordance with said edit command (column 7 lines 10-19 → Lang teaches the CPU is used to interpret the edit command from the user);*

*determining means for determining whether said edit command specifies a command for copying of said audio visual data (column 9 lines 37-63 → Lang teaches determining means is one of a desired command from the user to copy data);*

*controlling means which, if said edit command is determined to specify the copying of said audio visual data, then transfers said audio visual data from a copy source formed by one at least one recording/reproducing means for recording or reproducing said audio visual data, to a copy destination formed by either the same or another recording/reproducing means (column 9 lines 37-63 → Lang teaches when desired to copy the data is copied from the recording media to another media);*

*and if said edit command is determined to specify an editing action other than copying of said audio visual data, then transfers the unedited audio visual data reproduced from one of said at least one recording/reproducing means to said editing means for the specified editing action, and transfers the edited audio visual data coming from said editing means to either the same or another recording/reproducing means for storage therein, while synchronizing said editing means and the two recording/reproducing means in operation (column 10 lines 10-32 → Lang*

teaches when editing operations are selected the original version is stored into memory and the editing is accomplished by the user through control of the digital control unit).

Lang does not disclose *receiving, analyzing, editing, determining, and controlling a command specifying to edit data synchronously or asynchronously without synchronizing the two recording/reproducing means in operation*. However, Lindsey does teach *without synchronizing the two recording/reproducing means in operation* (column 2 lines 57 to column 3 line 3 → Lindsey teaches an asynchronous transfer mode of video and audio through a routing switcher).

Jouenne teaches a system that backs up data asynchronously or synchronously based on predefined criteria to allow for maximum efficiency in backing of data (column 2 lines 2-25, column 5 lines 16-45, Tables 1-4 – data can be backed up asynchronously or synchronously on request).

It would have been obvious to one of ordinary skill in the art at the time the invention was to have combined asynchronous transfer of Lindsey with the data processing of Lang and Jouenne to save time of development by optimizing backup/editing under all situations..

**As to dependent claim 3**, Lang discloses *wherein said at least one recording/reproducing means is incorporated in the apparatus* (column 3 lines 40-50 → Lang discloses the device consists of an AV recorder editor/transceiver and addition units all in a common housing).

**As to dependent claim 4**, Lang discloses *wherein said at least one recording/reproducing means is capable of recording or reproducing said audio visual data to*

*or from a randomly accessible storage medium* (column 4 lines 29-40 → Lang teaches that the VCU comprises of RAM which is used in conjunction with the CPU for interim data storage).

**As to dependent claim 5**, Lang discloses *wherein said edit command is recorded on a storage medium and reproduced therefrom by said at least one recording means* (column 6 lines 46-52, column 7 lines 13-15 → Lang discloses the edit commands are stored in ROM and are accessed by the DCU and CPU); *and*

*wherein said receiving means receives said edit command reproduced from said storage medium* (column 6 line 46 through column 7 line 5 → Lang teaches that the user accesses a user interface which is controlled by the DCU that comprises ROM to specify edit commands.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 6, and 7 have been considered but are moot in view of the new ground(s) of rejection as necessitated by the amendments to the claims.

However the Examiner will like to address the new prior art of record used in the rejection of the above listed claims. Jouenne is used to bridge the connection between Lang and Lindsay by providing motivation for combining the techniques of synchronous and asynchronous editing while providing additional support for allowing analyzing of a request to have data backed/edited synchronously or asynchronously.

### ***Conclusion***



Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrea N. Long whose telephone number is 571-270-1055. The examiner can normally be reached on Mon - Thurs 6:00 am to 3:00 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Doug Hutton can be reached on 571-272-4137. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Andrea Long  
July 17, 2008

/Rachna S Desai/  
Primary Examiner, Art Unit 2176